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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,583	01/23/2004	Oded Nahleili	1268-215	3022
22429 7590 03/27/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314			EXAMINER FARAH, AHMED M	
			ART UNIT 3735	PAPER NUMBER
			MAIL DATE 03/27/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/762,583

Applicant(s)

NAHLEILI, ODED

Examiner

Ahmed M. Farah

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/22/07; 9/21/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the broad recitation "intensity of between 200 and about 1000 millijoule/mm<sup>2</sup>" in line 2, and the claim also recites intensity of about "300 and about 700 millijoule/mm<sup>2</sup>" and between about "500 and about 700 millijoule/mm<sup>2</sup>" in lines 2-3, which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman US Patent No. 6,450,170.

Friedman discloses a method for treatment of migraine, tension-type headaches, and atypical facial pain by irradiating laser light to a desired tissue site. He further teaches that the use of laser energy for treatment of hard tissue, such as relieving temporomandibular joint pain, is well known in the art (see col. 4, lines 58-60).

The recitation in the claim that the treatment energy is "produced by an Erbium (Er) laser" is not given a patentable weight. To be entitled to weight ... structural limitations must affect method in a manipulative sense and not amount to mere claiming of use of a particular structure. Exparte Pfeiffer 782 O.G. 639, 1962 CD 408 (see also 135 USPQ 31).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-18 and 20 are again rejected under 35 U.S.C. 103(a) as being unpatentable over the ADKiT publication "Endoscopic Laser Lithotripsy of a Proximal Parotid Duct Calculus," Journal of Otolaryngology, April 30, 2001 in view of Teichman

et al. "Erbium: YAG Versus Holmium: YAG Lithotripsy," Journal of Urology, 165: Pages 876-879 (2001). The

ADKiT publication discloses a method for removing/treating proximal parotid duct calculus (salivary duct calculi), the method comprising the steps of irradiating to said calculus a laser energy produced by a holmium laser, and viewing the treatment site with an endoscopic/urethrosopic device. However, the publication fails to teach the use of Er:YAG laser, or the structure of the endoscopic device as presently claimed.

Teichman et al. teach a method for testing the efficiency between an Er:YAG and a Ho:YAG laser for lithotripsy (fragmenting calculus or stone). Their test suggested/proved that the Er:YAG laser is more efficient than the holmium laser for lithotripsy. As to the recited endoscope, the applicant admits that the claimed endoscope is one of the commercially available endoscopes by Karl Storz Ltd. (see paragraph [0052] of Pub. No. US 2004/0225283 A1.

Therefore, at the time of the applicant's invention, it would have been obvious to one skilled in the art to modify the teachings of the ADKiT publication in view of Teichman et al. and use Er:YAG laser as an equivalent alternative light source to provide the treatment energy. As suggested by Teichman et al., the use of the Er:YAG laser would enhance the efficiency of the treatment. It would have been further obvious to one skilled in the art to use any commercially available endoscope suitable for insertion of small body cavities as claimed, because no advantage of a particular type is disclosed.

***Response to Arguments***

Applicant's arguments filed on September 21, 2007, have been fully considered but they are not persuasive. The applicant makes the following arguments:

Applicant's arguments are mainly directed to the use of Erbium laser to provide the treatment energy. The applicant states that the ADKIT reference (the primary reference) is "a specialized otolaryngology publication" and employs a Holmium:YAG laser, and the Teichman et al. publication (the secondary reference) is specialized urology publication. The applicant further argues that, since these references are directed to different medical specialties, one of ordinary skill in the art would not have combined the teachings of these references or use an Erbium laser as claimed.

In response to this argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Furthermore, to be entitled to weight ... structural limitations must affect method in a manipulative sense and not amount to mere claiming of use of a particular structure. *Exparte Pfeiffer* 782 O.G. 639, 1962 CD 408 (see also 135 USPQ 31).

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**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M. Farah whose telephone number is (571) 272-4765. The examiner can normally be reached on Mon, Tue, Thur and Fri between 9:30 AM 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marmor II Charles can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ahmed M Farah/  
Primary Examiner, Art Unit 3735

December 26, 2007.